

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Corbett, et al.

International App. No.: PCT/US2004/038126

Group Art Unit:

International Filing Date: November 15, 2004

Examiner:

For: AMINOPHENYLCYCLOPROPYL CARBOXYLIC ACIDS AND DERIVATIVES AS AGONISTS TO GPR40

Commissioner for Patents
Washington, D.C. 20231

INFORMATION DISCLOSURE STATEMENT

Applicants request that the references identified on Form PTO-1449 appended hereto be considered by the Examiner and officially made of record in accordance with the provisions of 37 CFR 1.97

☐ Copies of the references are enclosed

☐ Copies of the references were submitted in parent application Serial No. _____. (37 CFR 1.98(d))

☒ A copy of the International Search Report which issued on International Application No. PCT/US2004/038126 is submitted herewith. All of the publications cited in the International Search Report are listed on the attached form PTO-1449 and Applicants understand that copies have been supplied to the U.S. Patent Office by the International Bureau.

A. ☒ The Information Disclosure Statement submitted herewith is being filed within three months of the filing date of the above application or date of entry into the national stage of an international application or before the mailing date of a first Office action on the merits, whichever event occurs last. 37 CFR 1.97(b).

OR

☐ The Information Disclosure Statement submitted herewith is being filed before the mailing of a first office action after the filing of a Request For Continued Examination under 37 C.F.R. 1.114 (37 C.F.R. 1.97(b)(4)).

B. ☐ The Information Disclosure Statement transmitted herewith is being filed after three months of the filing date of the above application or the date of entry into the national stage as set forth in § 1.491 of an international application or after the mailing date of the first Office Action on the merits, whichever event occurred last, but before the mailing date of either:

- (1) a final action under § 1.113 or
- (2) a notice of allowance under § 1.311,

whichever occurs first.

☐ Applicant hereby certifies that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this statement.

☐ Applicant elects the option to pay the fee set forth in 37 CFR 1.17(p) for submission of an Information Disclosure Statement under § 1.97(c) (\$240.00).

- C. ☐ The Information Disclosure Statement transmitted herewith is being filed **after** a final action under § 1.113, or a notice of allowance under § 1.311, whichever occurs first, but before the payment of the issue fee. Also enclosed is a copy of the International Search Report which Issued on International Publication No.

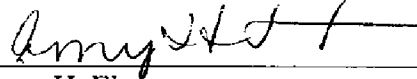
In accordance with the requirements of 37 CFR 1.97(d):

- ☐ Applicant hereby certifies that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this statement.
- ☐ Applicant hereby petitions for the consideration of the accompanying Information Disclosure Statement. 37 CFR 1.97(d)(ii).
- ☐ The petition fee set forth in § 1.17(i)(1) (\$130.00) is submitted herewith.

☒ Please charge any required fees to Deposit Account No.07-1392.

☐ A duplicate copy of this paper is attached.

Respectfully Submitted,



Amy H. Fix

Attorney for Appliant

Registration No. 42,616

Date: 17 May 2006

GlaxoSmithKline

Corporate Intellectual Property

5 Moore Drive, P.O. Box 13398

Research Triangle Park, NC 27709-3398

Telephone: (919) 483-8911

Facsimile: (919) 483-7988

INTERNATIONAL SEARCH REPORT

International Application No
PCT/US2004/038126

A. CLASSIFICATION OF SUBJECT MATTER

IPC 7 C07C229/46 C07C233/59 C07C323/32 C07D213/38 C07D277/28
C07D277/34 C07D295/13 C07D307/52 C07D333/20 C07D407/12
A61K31/196 A61K31/165 A61K31/341 A61K31/381 A61K31/426

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

IPC 7 C07C C07D

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practical, search terms used)

EPO-Internal, WPI Data, BEILSTEIN Data, CHEM ABS Data

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A	<p>ITOH Y ET AL: "Free fatty acids regulate insulin secretion from pancreatic beta cells through GPR40" NATURE, MACMILLAN JOURNALS LTD. LONDON, GB, vol. 422, no. 6928, 13 March 2003 (2003-03-13), pages 173-176, XP002903889 ISSN: 0028-0836 cited in the application</p>	1-37
A	<p>WO 02/057783 A (GLAXO GROUP LIMITED; SMITHKLINE BEECHAM P.L.C; ANDREWS, JOHN, LEON; BR) 25 July 2002 (2002-07-25)</p>	1-37

☒ Further documents are listed in the continuation of box C.

☒ Patent family members are listed in annex.

* Special categories of cited documents:

- "A" document defining the general state of the art which is not considered to be of particular relevance
- "E" earlier document but published on or after the international filing date
- "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)
- "O" document referring to an oral disclosure, use, exhibition or other means
- "P" document published prior to the international filing date but later than the priority date claimed

- "I" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
- "X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
- "Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art
- "&" document member of the same patent family

Date of the actual completion of the international search

6 April 2005

Date of mailing of the international search report

13/04/2005

Name and mailing address of the ISA

European Patent Office, P.O. 5818 Patentlaan 2
NL - 2280 HV Rijswijk
Tel. (+31-70) 340-2040, Tx. 31 651 epo nl
Fax: (+31-70) 340-3016

Authorized officer

Cooper, S

INTERNATIONAL SEARCH REPORT

International Application No
PCT/US2004/038126

C.(Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.

INTERNATIONAL SEARCH REPORT

international application No.
PCT/US2004/038126

Box II Observations where certain claims were found unsearchable (Continuation of item 2 of first sheet)

This International Search Report has not been established in respect of certain claims under Article 17(2)(a) for the following reasons:

1. ☒ Claims Nos.: —
because they relate to subject matter not required to be searched by this Authority, namely:

Although claims 33 and 34 are directed to a method of treatment of the human/animal body, the search has been carried out and based on the alleged effects of the compound/composition.
2. ☐ Claims Nos.:
because they relate to parts of the International Application that do not comply with the prescribed requirements to such an extent that no meaningful International Search can be carried out, specifically:
3. ☐ Claims Nos.:
because they are dependent claims and are not drafted in accordance with the second and third sentences of Rule 6.4(a).

Box III Observations where unity of invention is lacking (Continuation of item 3 of first sheet)

This International Searching Authority found multiple inventions in this international application, as follows:

1. ☐ As all required additional search fees were timely paid by the applicant, this International Search Report covers all searchable claims.
2. ☐ As all searchable claims could be searched without effort justifying an additional fee, this Authority did not invite payment of any additional fee.
3. ☐ As only some of the required additional search fees were timely paid by the applicant, this International Search Report covers only those claims for which fees were paid, specifically claims Nos.:
4. ☐ No required additional search fees were timely paid by the applicant. Consequently, this International Search Report is restricted to the invention first mentioned in the claims; it is covered by claims Nos.:

Remark on Protest

- ☐ The additional search fees were accompanied by the applicant's protest.
- ☐ No protest accompanied the payment of additional search fees.

Information on patent family members

PCT/US2004/038126

Form PCT/ISA/210 (patent family annex) (January 2004)

FORM PTO-1449 INFORMATION DISCLOSURE STATEMENT				ATTORNEY DOCKET NO. PR60416USW		INTERNATIONAL APP. NO. PCT/US2004/038126	
				APPLICANT CORBETT et al.			
				INTERNATIONAL FILING DATE 11/15/04		GROUP	
U.S. PATENT DOCUMENTS							
Examiner Initials		Patent Number	Issue Date	Name	Class	Subclass	Filing Date If Appropriate
Continue on page _____							
FOREIGN PATENT DOCUMENTS							
		Document Number	Publication Date	Country	Class	Subclass	Translation Yes No
/K.B./		02/057783	7/25/02				
Continue on page _____							
OTHER DOCUMENTS (Including Author, Title, Journal-Date, Page Number, Etc.)							
/K.B./		Itoh et al., "Free fatty acids regulate insulin secretion from pancreatic beta cells through GPR40," Nature, V422, N6928, pp. 173-176.					
Continue on page _____							
EXAMINER /Kristin Bianchi/					DATE CONSIDERED 01/20/2010		
EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.							